

subject matter in the disclosure. They have attempted herein to revise the claims to cover the subject matter which is allowable.

### REMARKS

Applicants have canceled Claims 14 and 16, have amended Claim 18 and have added new Claim 22. The claims have been amended to incorporate more specific language therein to distinguish the elements of the Claims from the disclosures of the cited references. New Claim 22 which replaces Claim 14 contains language which cure the defects resulting in the rejections of Claims 14 and 15 under 35 U.S.C. 112, second paragraph.

The rejection of Claims 16 and 17 has been obviated in view of the cancellation of Claim 16.

The Examiner is respectfully requested to reconsider his rejection of Claims 14 - 17 under 35 U.S.C. §102(b) as being anticipated by Aoyama, et al. (U.S. Patent 5,592,024).

The independent Claims defining the present invention provide for, *inter alia*, "planarizing said overcoated surface through chemical-mechanical operations, and removing said mask layer in all portions between said openings to a depth that establishes a selected dimension of the upper surface of said mask below said surface," and then "depositing a protective cap film on exposed overcoated surface and remaining exposed surface, said cap film minimizing leakage and improving electrical reliability."

Applicants do not concede that the Examiner's reading of the reference is correct such that each and every element claimed by Applicants is disclosed by the Aoyama reference. Nevertheless, Aoyama does not disclose the depositing of a protective cap on the exposed overcoated surface. Thus these claims are allowable now over Aoyama.

The Examiner is respectfully requested to reconsider his rejection of Claims 14 - 17 under 35 U.S.C. §102(e) as being anticipated by Watanabbe, et al. (U.S. Patent 6,043,146).

The independent Claims defining the present invention provide for, *inter alia*, “planarizing said overcoated surface through chemical-mechanical operations, and removing said mask layer in all portions between said openings to a depth that establishes a selected dimension of the upper surface of said mask below said surface,” and then “depositing a protective cap film on exposed overcoated surface and remaining exposed surface, said cap film minimizing leakage and improving electrical reliability.”

Applicants do not concede that the Examiner’s reading of the reference is correct such that each and every element claimed by Applicants is disclosed by the Watanabe reference. Nevertheless, Watanabe does not disclose the depositing of a protective cap on the exposed overcoated surface. Thus these newly revised claims are allowable now over Watanabe.

The Examiner is respectfully requested to reconsider his rejection of Claims 14 - 17 under 35 U.S.C. §102(e) as being anticipated by Usami, et al. (U.S. Patent 6,468,898).

The independent Claims defining the present invention provide for, *inter alia*, “planarizing said overcoated surface through chemical-mechanical operations, and removing said mask layer in all portions between said openings to a depth that establishes a selected dimension of the upper surface of said mask below said surface,” and then “depositing a protective cap film on exposed overcoated surface and remaining exposed surface, said cap film minimizing leakage and improving electrical reliability.”

Applicants do not concede that the Examiner’s reading of the reference is correct such that each and every element claimed by Applicants is disclosed by the Usami reference. Nevertheless, Usami does not disclose the depositing of a protective cap on the exposed overcoated surface. Thus these claims are allowable now over Usami.

Applicants respectfully submit that Aoyama, Watanabe and Usami, et al. do disclose some elements found in their invention but that is where the similarity ends. In order to support a proper "anticipation" rejection, the Examiner is obligated to establish that each and every element claimed by Applicants is disclosed in the reference. The citation of the elements in the 102(b) and 102(e) rejections are taken out of context as only the elements *per se* are pertinent. The sequence of their steps in their process do not anticipate Applicants' structure.

The Examiner is respectfully requested to reconsider his rejection of Claims 18 - 21 under 35 U.S.C. §103(a) as being unpatentable over Aoyama, et al. (U.S. Patent 5,592,024) in view of Watanabe, et al. (U.S. Patent 6,043,146).

The Examiner has conceded that the Aoyama, et al. reference does not disclose the claimed coating liner feature of the invention.

In analyzing the references cited, it is questionable whether the skilled artisan would look to Watanabe, et al. to supplement the teaching of the Aoyama, et al. primary reference. Considering what the essential features of each of the inventions in these patents, the skilled artisan would not utilize Watanabe, et al. in support of the Aoyama, et al. reference.

Aoyama, et al. discloses a semiconductor device having a wiring layer with a barrier layer. A substrate and a plurality of layers is disclosed. Watanabe, et al. discloses the use of a buffer film formed over an underlying film to protect the underlying film (an insulating film) from damage during a removal sequence. The buffer film is removed later. The sequence of steps in Watanabe, et al. is to protect an underlying film from damage. There is no suggestion in Aoyama, et al. to select two isolated layers found in Watanabe, et al. and include them in the Aoyama, et al. teaching.

The difference in the two inventions cited as prior art serve to rebut the rejection of the claims under 35 U.S.C. 103, Applicants submit that the prior art does not allow or support the conclusion of obviousness that the Examiner seeks to establish.

The references to Aoyama, et al. and Watanabe, et al. contain broad disclosures. It appears from a review of the references that if an element or step in the system is included in either of them, the Examiner is asserting that these elements, without more, are suitable to render obvious the present invention.

Applicants respectfully submit that the specificities of the disclosures do not rise to the level required to qualify as an appropriate reference with respect to Applicant's invention.

Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. (Citations omitted) In re Lonnie T. Spada et al., 911 F.2d 705, 708 (Fed. Cir. 1990)

Aoyama, et al. and Watanabe, et al., alone, or in combination, do not disclose or even imply the device and method of the present invention. In the rejection, the Examiner is selectively picking and choosing individual elements disclosed in the references to the exclusion of what the references as a whole teach to one skilled in the art. For example, to arrive at Applicants' invention, the person skilled in the art would have to randomly pick and choose among a number of different elements found in Watanabe, et al. with the only guidance as to what element(s) to select being provided by Applicants disclosure since Aoyama, et al. does not teach the same materials. Based upon the skilled artisan's reading and knowledge of the two systems disclosed and their respective objectives and how they are implemented, it is unlikely that the person skilled in the art would use Aoyama, et al. in combination with Watanabe, et al.

In order to analyze the propriety of the Examiner's rejections in this case, a review of the pertinent applicable law relating to 35 U.S.C. § 103 is warranted. The Examiner has applied the two references discussed above using selective combinations to render obvious the invention.

The Court of Appeals for the Federal Circuit has set guidelines governing such application of references. These guidelines are, as stated are found in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ, 543, 551:

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.

A representative case relying upon this rule of law is Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). The district court in Uniroyal found that a combination of various features from a plurality of prior art references suggested the claimed invention of the patent in suit. The Federal Circuit in its decision found that the district court did not show, however, that there was any teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one with ordinary skill in the art to make the combination. The Federal Circuit opined:

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. [837 F.2d at 1051, 5 USPQ 2d at 1438, citing Lindemann, 730 F.2d 1452, 221 USPQ 481, 488 (Fed. Cir. 1984).]

The Examiner has selected elements and steps from the cited references for the sake of showing the individual elements and/or steps claimed without regard to the total teaching of the two references.

The Examiner in his application of the cited references is improperly picking and choosing. The rejection is a piecemeal construction of the invention. Such piecemeal reconstruction of the prior art patents in light of the instant disclosure is contrary to the requirements of 35 U.S.C. § 103.

The ever present question in cases within the ambit of 35 U.S.C. § 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the teachings of the prior art at the time the invention was made. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Emphasis in original) In re Wesslau 147 U.S.P.Q. 391, 393 (CCPA 1965)

This holding succinctly summarizes the Examiner's application of references in this case, because the Examiner did in fact pick and choose so much of the Watanabe, et al. reference with Aoyama, et al. to support the rejections and did not cover completely in the Office Action the full scope of what these varied disclosure references fairly suggest to one skilled in the art.

Further, the Federal Circuit has stated that the Patent Office bears the burden of establishing obviousness. It held this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. [837 F.2d at 1075, 5 USPQ 2d at 1599.]

The court concluded its discussion of this issue by stating that teachings or references can be combined only if there is some suggestion or incentive to do so.

In the present case, the skilled artisan, viewing the references would not be directed toward Applicants device and method. There can reasonably be no system emanating from the Aoyama et al. and Watanabe, et al. references as the basic systems of the two references are different. There is no proper basis to combine them.

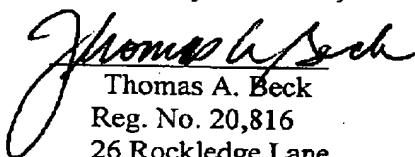
Applicants have attempted in this response to amend Claim 14 to read as Claim 22 as well as Claim 18, and to place the amended claims in a form which should result in their allowability. If the Examiner wishes to discuss via telephone the substance of any of the proposed claims contained herein with the intent of putting them into an allowable form, Applicants' attorney will be glad to speak with him at a mutually agreeable time and will cooperate in any way possible.

Applicants request an extension of time of three (3) months within which to file a response to the Official Action. A check in the amount of \$980.00 is enclosed. If additional funds are needed or the instant payment is in excess of what is required, the Commissioner is authorized to debit/credit Deposit Account 02-1651.

In view of the arguments and modifications to the claims, allowance of this case is warranted. Such favorable action is respectfully solicited.

In response to the Notice of Non-Compliant Amendment dated April 25, 2005, Applicants request an extension of time of three months within which to respond. The Commissioner is authorized to debit Deposit Account 02-1651 for the extension fee.

Respectfully submitted,

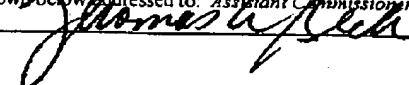
  
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I certify that this amendment was deposited with the United States Postal Service on the date shown below addressed to: Assistant Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature   
 Name: Thomas A. Beck

Date: April 12, 2005 and

I further certify that this amendment in response to the Notice of Non-Compliant Amendment was telefaxed to telefax number (571) 273-8300 on the date shown below addressed to: Assistant Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature 

Date: August 24, 2005